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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/264,808	03/09/1999	KAZUHIRO SUGAWARA	35.C9525-D2/	3747

5514 7590 11/06/2002

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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 11/06/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/264,808

Applicant(s)
Sugawara et al

Examiner
Mark Wallerson

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2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 25, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-77 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10 6) ☐ Other:

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Part III DETAILED ACTION

Please note that a new Examiner has been assigned to this application.

Notice to Applicant(s)

1. This action is responsive to the following communications: amendment filed on 9/25/2002.

2. This application has been reconsidered. Claims 39-81 are pending.

Continued Prosecution Application

3. The request filed on 8/5/2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/264,808 is acceptable and a CPA has been established. An action on the CPA follows.

Allowable Subject Matter

4. The indicated allowability of claims 38-69 is withdrawn in view of the newly discovered reference(s) to Lin and Irribarren. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 38, 47, 54, and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 38, 47, 54, and 63 recite the limitation "the code data previously set" in the claims. There is insufficient antecedent basis for this limitation in the claim.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 70-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 70 and 74, it is unclear whether "a device code" in lines 2 and 3 of claim 70 and lines 3 and 4 of claim 74 is the same "a device code" in line 6 of claim 70 and line 7 of claim 74.

10. Claims 70 and 74 recite the limitation "the device code" in line 7 of claim 70 and line 8 of claim 74. Which "a device code" is Applicant referring to? There is insufficient antecedent basis for this limitation in the claim.

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Claim Objections

11. Claim 59 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 59 is identical to claim 57, and they both depend on claim 54.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin (U. S. 4,991,200).

With respect to claims 38, 45, 46, 54, 61, 62, 63, 68, and 69 Lin discloses a computer apparatus (3, figure 1 or PC, figure 8) comprising reception means (faxcard or unit 1, figure 1) for receiving code data from a device control apparatus (2, figure 1), the device control apparatus controlling a device (computer) in accordance with the code data (column 8, lines 19-24), and converting means (5) for converting the code data received by the reception means into code data for displaying or printing (column 8, lines 19-24).

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With regard to claims 39, 40, 55, and 56 Lin discloses converting the code data into code data for display or printing (column 1, lines 53-57).

With respect to claims 41, 42, 57, 58, 59, 64, and 65 Lin discloses a communication line (figure 1 and column 8, lines 19-26).

With regard to claim 43 and 66 Lin discloses an image formation device (which reads on a computer) (3).

With respect to claim 44, 60, and 67 Lin discloses a facsimile (2).

With regard to claims 47, 52, and 53 Lin discloses converting means (5) for converting code data inputted from a keyboard (computer) into data for a device control apparatus (fax) (column 8, lines 19-28), the device control apparatus controlling a device (fax) in accordance with the code (column 8, lines 19-28).

With respect to claims 48 and 49, Lin discloses a communication line (figure 1).

With regard to claim 50, Lin discloses an image formation device (which reads on a computer) (3).

With respect to claim 51, Lin discloses a facsimile (2).

With regard to claim 70, 73, 74, and 77, Lin discloses a first conversion unit (5) adapted to convert an inputted computed code into a device (facsimile) code (column 8, lines 24-28); a transmission unit (4) to transmit the converted device code to the facsimile; a reception means (5) to receive a device code from the device (facsimile) (column 8, lines 19-28), and a second

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conversion unit (5) for converting (the) received device code into a computer code (column 8, lines 19-28).

With respect to claims 71, 72, 73, and 74, the device is a facsimile (2) connected to a communication line (figure 1).

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 73, 74, 75, 76, and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Irribarren (U. S. 5,737,395).

With respect to claims 38, 45, 46, 54, 61, 62, 63, 68, and 69 Irribarren discloses a computer apparatus (figure 1) comprising reception means (100, figure 3) for receiving code data from a device control apparatus (fax), the device control apparatus controlling a device (computer) in accordance with the code data (column 10, lines 43-64), and converting means () for converting the code data received by the reception means into code data for displaying or printing (column 16, lines 18-28).

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With regard to claims 39, 40, 55, and 56 Irribarren discloses converting the code data into code data for display or printing (column 16, lines 18-28).

With respect to claims 41, 42, 57, 58, 59, 64, and 65 Irribarren discloses a communication line (104, figure 1).

With regard to claim 43 and 66 Irribarren discloses an image formation device (which reads on a computer) (108).

With respect to claim 44, 60, and 67, Irribarren discloses a facsimile (112).

With regard to claims 47, 52, and 53, Irribarren discloses converting means (100) for converting code data inputted from a keyboard (computer) into data for a device control apparatus (fax) (754, figure 7), the device control apparatus controlling a device (fax) in accordance with the code (column 10, lines 43-64).

With respect to claims 48 and 49, Irribarren discloses a communication line (figure 1).

With regard to claim 50, Irribarren discloses an image formation device (which reads on a computer) (108).

With respect to claim 51, Irribarren discloses a facsimile (112).

With regard to claims 70, 73, 74, and 77, Irribarren discloses a first conversion unit (100) adapted to convert an inputted computed code into a device (facsimile) code (column 10, lines 56-64); a transmission unit (756) to transmit the converted device code to the facsimile; a reception means (100) to receive a device code from the device (facsimile) (column 16, lines 18-

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288), and a second conversion unit (100) for converting (the) received device code into a computer code (column 16, lines 18-28).

With respect to claims 71, 72, 73, and 74, Irribarren discloses the device is a facsimile (112) connected to a communication line (figure 1).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Wallerson whose telephone number is (703) 305-8581.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

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MARK WALLERSON
PRIMARY EXAMINER

MARK WALLERSON